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OFFICE OF PETITIONS

In re Application of :
Errico et al. :
Application No. 10/784,645 :
Filed: February 23, 2004 : DECISION ON PETITION
Attorney Docket No. F-310 (532/21) :

This is a decision on the petition filed July 21, 2004 (certificate of mailing July 16, 2004), requesting that the Office consider Figures 1g-1n as deposited on February 23, 2004, with the original application papers.

The application was filed on February 23, 2004. However, on May 19, 2004, the Office mailed a "Notice of Omitted Items" stating that the application had been accorded a filing date of February 23, 2004; however, figures 1g-1n described in the specification appeared to have been omitted. In response, petitioner admits figures 1g-1n were inadvertently omitted. Nonetheless, petitioner asserts the presence of the drawings on filing via an incorporation by reference statement.

The petition is dismissed.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

The PTO file is the official record of the papers originally filed in this application. A review of the official file confirms that no drawing sheets containing figures 1g-1n were filed on February 23, 2004, since no such drawings are present in the file. Petitioners do not provide evidence, such as an itemized postcard

receipt, that the omitted figures were among the papers present in the application on filing. Moreover, omitted drawings are not considered present in the application on filing by virtue of either an incorporation by reference statement. See MPEP 201.06(c).

Nonetheless, with a proper incorporation by reference statement, applicants may amend an application to include omitted drawings. However, no petition under 37 CFR 1.182 is necessary for that purpose. New drawings may be entered by the primary examiner without petition so long as the new drawings contain no new matter. See MPEP § 608.02(a).

Accordingly, the petition is inappropriate and is subject to dismissal.

It is noted that the application transmittal letter identified this application as a continuation of prior application No. 10/425,267 and specifically incorporated by reference the disclosure of the prior application. MPEP 201.06(c) states that:

. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. . . . The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference. (emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, the drawing of Figures 1g-1n are not new matter if they were a part of the disclosure of the prior application.

The Office acknowledges receipt of a preliminary amendment requesting the entry of the sheets of drawings, containing figures 1g-1n submitted with the instant petition.

The correspondence address on the petition differs from the correspondence address of record. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

The application will be processed by the Office of Initial Patent Examination with a **filing date of February 23, 2004**, including an indication in Office records that 3 sheets of drawings were present on filing.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 306-0251.

A handwritten signature in black ink, appearing to read "Charlema R. Grant". The signature is fluid and cursive, with a long horizontal stroke at the end.

Charlema R. Grant
Petitions Attorney
Office of Petitions

cc: Timothy Gibson
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